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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/527,628	05/25/2005	Prasad Koteswara Kapa	PI/4-32685A	9537

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CORPORATE INTELLECTUAL PROPERTY
ONE HEALTH PLAZA 104/3
EAST HANOVER, NJ 07936-1080

EXAMINER

RODRIGUEZ-GARCIA, VALERIE

ART UNIT	PAPER NUMBER
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1626

MAIL DATE	DELIVERY MODE
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11/06/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/527,628	Applicant(s) KAPA ET AL.	
	Examiner VALERIE RODRIGUEZ-GARCIA	Art Unit 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) 10-37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,5 and 6 is/are rejected.
- 7) ☒ Claim(s) 2-4 and 7-9 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>03/14/05</u> . | 6) <input type="checkbox"/> Other: _____ |

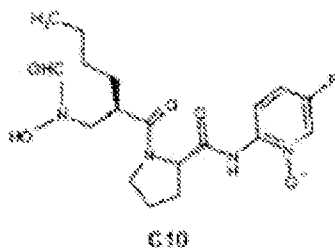
DETAILED ACTION

Status of the Claims

Claims 1-37 are currently pending.

1. Applicant's election without traverse of Group I, claims 1-9, drawn to a method of making compound of formula (VIII) where $X = CH_2$, $n = 1$ and R_2 , R_3 , R_4 and R_5 are independently hydrogen or aliphatic, in the reply filed on 10/20/08 is acknowledged.

The following elected species is also acknowledged:



Subject matter not encompassed by elected Group I are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to non-elected inventions there being no allowable generic or linking claim. Election was made without traverse in the reply filed on 10/20/08.

Priority

The current application is a 371 of PCT/EP03/10416 filed on 09/18/2003, which claims priority of application 60/411,920 (09/19/2002) and 60/480,242 (06/20/03).

Note

The examiner changed the title of the invention to a more descriptive title.

The process elected by the Applicant is free of the art.

Pursuant to Applicant's response, claims 1-37 are pending, claims 10-37 are withdrawn, and claims 1-9 are treated on the merits in this action. This is the first Office Action on the merits of the claims.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In the instant case, claim 1 discloses the variables R is alkyl and G is -OH or O M, wherein M is a metal or an ammonium moiety. R, G and M variables are currently not part of the claimed invention and one of ordinary skill in the art would not know what they represent.

3. Claims 5-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 5-6 are dependent on claim 2. Claim 5 recites the limitation "wherein R₇ is hydrogen and R₈ is fluoro". Claim 6 recites the limitation "wherein R₇ is alkyl and R₈ is hydrogen". There is insufficient antecedent basis for this limitation in the claims because claim 2 does not contain such variables.

Claim Objections

Claims 2-4 and 7-9 are objected to as been dependent upon rejected claims.

Conclusion

No claims are allowable.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to VALERIE RODRIGUEZ-GARCIA whose telephone number is (571)270-5865. The examiner can normally be reached on Monday-Friday, 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane can be reached on 571-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/Kamal A Saeed,./
Primary Examiner, Art Unit 1626